

REMARKS

This response is a full and complete response to the non-final Office Action mailed March 24, 2008. In the present Office Action, the Examiner has noted that claims 1-47 are pending, that claims 1-47 stand rejected under 35 U.S.C. §102.

In view of both the amendments presented above and the following remarks, it is submitted that the claims pending in the application are novel and nonobvious. It is believed that this application is in condition for allowance. By this response, reconsideration of the present application is respectfully requested.

It is noted that the Examiner has objected to claims 26, 43, 44 and 45 for various informalities. These objections are traversed in part.

Claims 43 and 44 have been amended to correct minor and inadvertent typographical errors. It is respectfully asserted that these minor claim amendments do not narrow the literal scope of the claims and, therefore, no prosecution history estoppel results. It is requested that the Examiner withdraw his objection to these claims.

With respect to claims 26 and 45, Assignee does not agree with the Examiner's position. The terms "user device" and "client" are well-accepted by those of ordinary skill in the art most pertinent to the subject matter of this application and, furthermore, these terms are supported by the specification. Therefore, it is requested that the Examiner also withdraw his objection to these claims.

In the Action, claims 1-47 were rejected under 35 USC § 102 as being anticipated by US Patent No. 6, 442,285 to Rhoads et al. (hereinafter "Rhoads"). In response, Assignee respectfully traverses the basis of such rejection. For at least the reasons set forth below, Assignee submits that claims 1-47 are not anticipated by Rhoads.

The Examiner is reminded that the Manual of Patent Examining Procedure (“MPEP”), in § 2131, states:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”

Verdegaal Bros. V. Union Oil Co. California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Thus, under 35 U.S.C. § 102, a claim is anticipated *only if* each and every element of the claim is found in the cited document. It is respectfully asserted that the Examiner has failed to meet his or her burden in this respect.

We begin with claim 1. Claim 1 recites:

A method for delivering an asset over a network comprising:

supplying an asset list over said network to a user device, said user device including a client process; and
delivering said asset over said network to said user device if a predetermined constraint is satisfied.

It is respectfully asserted that Rhoads does not show or describe supplying an asset list over a network to a user device. Therefore, the Examiner has failed to successfully make a *prima facie* case of anticipation.

A close reading of Rhoads makes clear that it is not directed to supplying an asset list. At best, Rhoads is directed to individual objects, assets or works. For example, it states, at column 4, lines 59-62: “...the payload can include a digital object identifier – an ISBN-like number issued by a central organization (e.g. a rights management organization) to uniquely identify the work.” Rhoads, at the top of column 5, goes on to describe a Master Global Address (MGA); however, again, MGAs appear to be directed to individual objects or assets – not to a list of assets.

The Examiner himself points to column 25; however, Rhoads at column 25, lines 51-53, states: "Consider an application program or other client process that receives a watermarked media object. The watermark includes an MGA for that object...Stored at the MGA site is meta-data corresponding to the object...." Therefore, it is apparent that the subject matter of Rhoads is not directed to supplying a list of assets. It is, therefore, respectfully requested that the Examiner withdraw his or her rejection of claim 1.

The remaining rejected claims 2-47 depend from claim 1 or contain similar limitations and patentably distinguish on at least the same or on a similar basis. Therefore, it is respectfully asserted that claims 1-47 patentably distinguish from Rhoads. It is, therefore, requested that the rejection of these claims also be withdrawn and that these be permitted to proceed to issuance without delay.

Failure of the Assignee to respond to a position taken by the Examiner is not an indication of acceptance or acquiescence of the Examiner's position. It is believed that the Examiner's positions are rendered moot by the foregoing and, therefore, it is not necessary to respond to every position taken by the Examiner with which Assignee does not agree in this or other correspondence. Instead, it is believed that the foregoing addresses the issues raised by the Examiner and that the present claims are in condition for allowance.

Conclusion

The foregoing is submitted as a full and complete response to the Office Action mailed March 24, 2008. In view of the foregoing amendment and remarks, Assignee respectfully submits that pending claims are in condition for allowance and a notification of such allowance is respectfully requested.

If the Examiner believes that there are any remaining informalities that can be corrected by an Examiner's amendment, a telephone call to the undersigned at 503.439.6500 is respectfully solicited.

In the event there are any errors with respect to the fees for this response or any other papers related to this response, the Director is hereby given permission to charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account No. 50-3130.

Respectfully submitted,

Dated: /July 23, 2008/

By /Howard A. Skaist/
Howard A. Skaist, Patent Attorney
Registration No. 36,008

Customer No. 60226
c/o Berkeley Law & Technology Group, LLP
17933 NW Evergreen Parkway, Suite 250
Beaverton, OR 97007
503.439.6500 (office)
503.439.6559 (fax)

cc: Docketing
Accounting